

REMARKS

This is in full and timely response to the above-identified Office Action. The above listing of the claims supersedes any previous listing. Favorable reexamination and reconsideration are respectfully requested in view of the preceding amendments and the following remarks.

Claim Amendments

In this response, claim 1 has been amended to differentiate over the art applied. Claims 2-6 have been amended to improve/correct form, syntax and antecedent basis issues. New claims 9-13 have been added to define further aspects of the invention. Support for the amendments and the new claims are found in the specification as originally filed. For example, see paragraph [0022] of publication No. 2006/0014874 for the amendments to claim 1, [0013] for the subject matter presented in new independent claims 10 and 13, [0023] for dependent claims 9 and 11, and [0048] for the subject matter of newly presented dependent claim 12.

Rejections under 35 USC § 103

The rejection of claims 1-8 under 35 USC § 103(a) as being unpatentable over Sawada et al. or Shah et al., is, to the degree that is still relevant to the claims as amended, respectfully traversed.

As the Examiner is aware, in order to establish a *prima facie* case of obviousness, it is necessary to show that the hypothetical person of ordinary skill would, without any knowledge of the

claimed subject matter and without any inventive activity, be motivated to arrive at the claimed subject matter given the guidance of the cited references when each is fully considered as statutorily required.

Sawada et al.

Sawada et al., is such that the only reference to molybdenum is in paragraph [0101] and this indicates that it can be added in addition to zinc borate. That is to say, zinc borate is disclosed throughout the document as being the material which is primarily used to provide flame retarding properties albeit zinc borate in a particular form. That is to say, in paragraphs [0009] and [0010] it is stated that:

[0009] It is, therefore, an object of the present invention to provide a zinc borate having a particular crystallite size and containing very little sodium components, and a method of preparing the same.

[0010] Another object of the present invention is to provide a zinc borate which excellently disperses in a resin, markedly improves smoothness, luster and appearance of the surfaces of a resin blended therewith, and maintains, on an excellent level, the electric properties of the resin blended therewith as a flame-retarding agent or a smoke-suppressing agent, and a method of preparing the same.

Attention is also called to paragraph [0073] to [0082] to

enhance the clear intention of Sawada et al. to use zinc borate as the main fire/smoke retardant. Finally, in paragraph [0101] are other materials mentioned and then only in combination with the main ingredient. Viz:

[0101] In **addition** to the above, there can be used oxides, hydroxides or sulfates of antimony, zirconium and **molybdenum**, zinc stannate, zinc hydroxystannate, halogen-containing flame-retarding agent, phosphoric acid ester-type flame-retarding agent and halogenophosphoric acid ester-type flame-retarding agent in one kind or in a combination of two or more kinds.

Note must be had to the fact that this is the sole mention of molybdenum in the entire document. Thus, the question is why would the hypothetical person of ordinary skill be led toward the claimed subject matter given the overwhelming disclosure of zinc borate vis-à-vis the mere mention that oxides, hydroxides or sulfates of antimony, zirconium and molybdenum, zinc stannate, zinc hydroxystannate, halogen-containing flame-retarding agent, phosphoric acid ester-type flame-retarding agent and halogenophosphoric acid ester-type flame-retarding agent in one kind or in a combination of two or more kinds, could be used in addition to the zinc borate?

Unless the examiner can come up with a cogent reason why the hypothetical person of ordinary skill would move to use select hydroxy stannate and molybdenum oxide (the latter being mentioned only once in the whole document) as per the amended claims, out of

the all of the disclosed materials, the rejection must be deemed untenable and withdrawn. That is to say, the rejection is obviously based on "its known so its obvious."

It is submitted, that being known does not naturally result in something being obvious whenever it is used. If this were true, nothing would be patentable - everything being known and all combinations being combinations of known materials.

In light of this, it is suggested that the rejection appears to be guided by a full working knowledge of the claim subject matter.

In this rejection, the examiner's position is that "[G]iven that each of the **claimed components** is shown and suggested to be used in combination, one of ordinary skill would be motivated to utilize them **as claimed**" (emphasis added). Noting the scant disclosure of what is disclosed in Sawada et al. (and Shah et al. discussed below) regarding what is actually disclosed in the references, this is essentially an admission that the claims have been used as a guide for hindsight application of the claimed subject matter.

The Applicants are aware of *In re McLaughlin* 443 F.2d 1392, 170 USPQ 209 (CCPA 1971) and its holding that any judgment on obviousness is in a sense necessarily a reconstruction of based upon hindsight reasoning and is proper, so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from the applicant's disclosure. However, the fact that the claimed subject matter is barely disclosed in at

least one of the references clearly suggests that claims have been used to extensively ignore much of the disclosure and selectively pick and choose from the available teachings/disclosures for the sake of rejection.

Attention is also called to the fact that the references which are cited are applied individually and as such the arguments presented in this response inherently must deal with each reference individually. The Examiner is therefore requested to avoid an improper reliance on *In re Keller* (642 F.2d 413, 208 USPQ 871 (CCPA 1981)).

Further, and more importantly, it is to be noted that the main thrust of *In re Keller* is that "the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference, nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." (Emphasis added)

In this case, the teachings of Sawada et al. are insufficient to lead the hypothetical person of ordinary skill to the conclusion which is purported to be obvious in this rejection. Indeed, if Sawada et al. were to be considered as a whole it is clear that the result would be based on zinc borate and not the combination of elements as currently recited in independent claims 1 and 9.

Shah et al.

Shah et al. is such that the only disclosure of molybdenum is

in paragraph [0002] wherein it is indicated that it suffers from the drawback of being expensive. Paragraph [0010] of this reference indicates that: [I]n accordance with the invention Shah et al.), the heterocyclic tin flame retardant/smoke suppressant additive is prepared by reacting (i) a trisubstituted triazine compound with (ii) a tin-containing compound This is a very particular structure and is not disclosed in a manner that it could be ignored in favor of other materials including the denigrated molybdenum.

In light of the fact that molybdenum is indicated as being expensive in the opening paragraphs of the Shah et al. reference and indicated as therefore not being preferred, it is self-evident that the hypothetical person of ordinary skill would be guided away from its use and would rather be effectively directed to use the structure/composition disclosed and claimed in Shah et al. if the content of the Shah et al. reference were to be fully considered as is statutorily required.

Other shortcomings in this rejection are that the subject matter of the dependent claims has not been fully considered. For example, claim 2 sets forth compounds to be used as processing aids; claim 4 calls for a surface-coated anti-smoke agent. Neither of these requirements have been addressed. Further, the issue of the color difference characteristics recited in claim 8 has not been addressed.

Conclusion

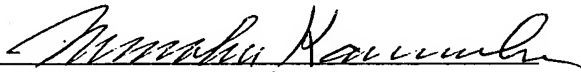
The cited references do not disclose or suggest the specific compositions as clearly defined in claim 1 and new claim 10.

It is respectfully submitted that the claims as they have been amended and newly presented are allowable over the art which has been applied in this Office Action. Favorable reconsideration and allowance of this application are courteously solicited.

Three month extension of time is hereby requested. A credit card authorization form in the amount of \$1,050.00 is attached herewith for the three month extension of time.

Respectfully submitted,

by



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